

REMARKS

Applicant has carefully reviewed the Office Action mailed August 14, 2008 and offers the following remarks to accompany the above amendments.

Claim 1 has been amended to clarify what is being claimed. No new matter has been added and no new search is required.

Claims 1-17 remain pending.

Initially, Applicant wishes to thank the Examiner for indicating that claim 15 would be allowable if rewritten in independent form. As will be detailed below, claim 12, the base claim from which claim 15 depends, is patentable over the cited references. Therefore, Applicant will refrain from amending claim 15 at this time. Nevertheless, Applicant reserves the right to rewrite claim 15 at a later time.

The drawings were objected to under 37 C.F.R. § 1.83(a) as allegedly not showing every feature of the invention that is specified in the claims. In particular, the Patent Office states that the call agent and computer program must be shown in the drawings. Applicant respectfully traverses.

With respect to the call agent of the claims, i.e., claims 12-15 and 17, Applicant points out that Figure 3 shows call agents 20-1 and 20-2 (see also Specification, page 7, line 18 through page 10, line 21). Thus, the claimed call agent is shown in the drawings.

With respect to the computer program of claim 16, the Specification clearly points out that a computer program may execute on a call agent according to the invention (see Specification, page 5, lines 8-17). In fact, the Specification states that the call agents 20-1 and 20-2 of Figure 3 may contain, or have access to, a model of the network conceptually in the form shown in Figure 5, and this topology could be held in a database, which allows tree traversal and thus would be constructed in the form of data held in a storage means and operated upon by computer processing means (Specification, page 8, lines 1-5). Therefore, a practical implementation of the invention is disclosed as being likely to take the form of additional software within a call agent. *Ibid.* In light of the disclosure in the Specification, Applicant respectfully submits that one of ordinary skill in the art would understand that the invention could be implemented in a computer program, in the form of software within the call agents 20-1 and 20-2, as shown in Figure 3. Drawings are required only “where necessary for the understanding of the subject matter sought to be patented.” 37 C.F.R. § 1.81(a). No additional

drawings are required for one of ordinary skill in the art to understand that the invention could be implemented in a computer program, as recited in claim 16, in the form of software within the call agents 20-1 and 20-2, as shown in Figure 3, and discussed on page 5, lines 8-17, and page 8, lines 1-5, of the Specification. Thus, Applicant respectfully submits that the drawings do not need to be amended.

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to clarify that a plurality of media proxies is linked to at least one of the nodes in the nodular network model in a list, and after each node traversed during the traversal of the nodular network model is checked for a list of media proxies, a media proxy is selected from the list to be the media proxy for the path. Applicant respectfully submits that claim 1 as amended is definite. Thus, the rejection under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite, should be withdrawn.

Claim 16 was rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses. In the recent Federal Circuit decision *In re Bilski*, the Federal Circuit held that for a claim to be patent eligible under 35 U.S.C. § 101, it must be either (1) tied to a particular machine or apparatus; or (2) transform a particular article into a different state or thing. *In re Bilski*, __ F.3d __, slip op. at 10. In the present application, claim 16 meets both of these tests. Claim 16 is tied to a particular machine or apparatus, namely a computer program that executes on a call agent which is arranged to setup a media path between data endpoints in networks separated by network address translation. Moreover, the computer program of claim 16 is adapted to execute on the call agent to cause the call agent to read a model of a network formed as a plurality of nodes which has a plurality of media proxies linked to at least one node of the plurality of nodes in a list, to receive a path setup request which specifies media endpoints for the media path, to read the model and traverse the model in a predetermined pattern dependent on the specified media endpoints, to check for a list of media proxies at each node traversed during traversal of the model, to determine the availability for at least one media proxy and to select a media proxy from the list found during traversal of the model as the media proxy for the media path. Thus, the computer program causes the call agent to do a number of steps, which results in a media proxy being selected from a list to be the proxy

for the path between data endpoints. A media proxy, which was not the proxy prior to the execution of the computer program, is selected as the media proxy after the computer program executes on the call agent. This is a transformation of the media proxy. Accordingly, the computer program of claim 16 is tied to a particular machine or apparatus and transforms a particular article into a different state or thing. Therefore, claim 16 is patent eligible under 35 U.S.C. § 101. *In re Bilski*, __ F.3d __, slip op. at 10.

Claims 1-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0186685 A1 to *O'Brien, Jr. et al.* (hereinafter "*O'Brien*") in view of U.S. Patent No. 6,930,983 to *Perkins et al.* (hereinafter "*Perkins*") and further in view of U.S. Patent Application Publication No. 2004/0054805 to *Sen et al.* (hereinafter "*Sen*"). Applicant respectfully traverses. According to Chapter 2143.03 of the M.P.E.P., in order to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." If the Patent Office cannot establish obviousness, then the claims are allowable.

Applicant respectfully traverses the rejection of claims 1-17 under 35 U.S.C. § 103(a) in light of the fact that *Sen* and the present application were both owned by, or subject to an obligation of assignment to, the same entity at the time the present invention was made. 35 U.S.C. § 103(c) states that subject matter developed by another person, which qualifies as prior art only under 35 U.S.C. § 102(e), (f), or (g), shall not preclude patentability if the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See also M.P.E.P. § 706.02(l)(1) and (l)(2). *Sen* only qualifies as prior art under 35 U.S.C. § 102(e) because *Sen* was not published until March 18, 2004, which is after the September 29, 2003 filing date of the present application. Since *Sen* only qualifies as prior art under 35 U.S.C. § 102(e), and *Sen* and the present application were both owned by, or subject to an obligation of assignment to, the same entity at the time the present invention was made, then 35 U.S.C. § 103(c) applies and *Sen* cannot be used to preclude patentability. Applicant hereby submits a **Statement of Common Ownership** under 35 U.S.C. § 103(c).

In light of the common ownership of *Sen* and the present application at the time that the present invention was made, Applicant respectfully requests that the rejection of claims 1-17

under 35 U.S.C. § 103(a) as being unpatentable in view of *O'Brien*, *Perkins*, and *Sen* be withdrawn.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

STATEMENT OF COMMON OWNERSHIP REQUIRED BY 35 U.S.C. § 103(c)

Applicant hereby makes a statement that the present application and U.S. Patent Application Publication No. 2004/0054805 A1 to *Sen* were, at the time the invention of the present application was made, both owned by Nortel Networks Limited, or subject to an obligation of assignment to Nortel Networks Limited, the assignee of the present application.

Respectfully submitted,
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